

### Remarks

Claims 1-33 are pending in the application, and are subject to a Restriction requirement under 25 U.S.C. 121. In a telephone call with the Examiner on 8/29/05, Applicant's representative provisionally elected to prosecute the invention of Group I (claims 1-29). The Applicant hereby confirms election without traverse of Group I (claims 1-29) for further prosecution in the present application. This election is made without prejudice, and without disclaimer of the subject matter of the non-elected claims. Non-elected claims 30-33 (Group II) have been canceled. Claim 22 has been amended to correct a typographical error.

Independent Claim 1 and depending claims 2 and 5-7 stand rejected under 35 USC 102(b) as being anticipated by published U.S. Patent Application No. 10/078,031 by **Leist et al.** (Pub. No. 2002/0179255). Independent Claims 1, 8, 22, and 27 and dependent claims 2-7, 9-21, 23-26, and 28-29 stand rejected under 35 USC 103(a) as being unpatentable over **Leist** in view of U.S. Pat. No. 6,446,695 to **Forsland**. The Applicant respectfully traverses the rejections of claims 1-29.

#### 1. Claims 1, 2 and 5-7 are Novel Over Leist et al.

Independent Claim 1 and depending claims 2 and 5-7 stand rejected under 35 USC 102(b) as being anticipated by published U.S. Patent Application No. 10/078,031 by **Leist et al.** (Pub. No. 2002/0179255). In order for a claim to be anticipated by a reference under 35 USC 102(b), the reference must disclose every limitation recited in the claim.

Independent Claim 1 and depending claims 2 and 5-7 each recite an "overhead garage door comprising a plurality of rectangular garage door sections, the sections being pivotally connected together one above the other, each door section including at least one thin-walled face panel and one or more patterns embossed in the face panel, *wherein the embossed patterns in the face panels provide the garage door with the simulated appearance of at least two separate, cooperating vertically-hung doors when the garage door is in a closed position.*" (emphasis added) **Leist** does not describe such a door structure. Indeed, **Leist** describes a substantially

conventional sectional overhead door having a combined weather seal and wear insert between adjacent door sections. Leist does not disclose a door comprising a plurality of door sections having thin-walled face panels with embossed patterns that combine to provide the door with the simulated appearance of *at least two vertically-hung doors* as recited in the claims.

The Examiner apparently finds that the required simulated appearance of the door recited in independent claim 1 is either unclear or indefinite. The Applicant respectfully disagrees. The present specification expressly defines the phrase "vertically hung doors" as the phrase is used in independent claim 1:

The term "vertically hung" as used herein refers to doors hung in a manner such that the doors remain vertical in both an open and a closed position. Often, authentic wooden carriage house doors are hinged along their outermost lateral edges, or are suspended on rails such that the doors slide apart horizontally to open. Accordingly, such doors often include a vertical separation between the abutting edges of the two doors.

(p. 3, lines 12-16) Leist does not disclose every limitation recited in any one of claims 1, 2 and 5-7, and the rejection of claims 1, 2 and 5-7 under 35 USC 102(b) should be withdrawn.

In addition, the Office Action appears to indicate that the Examiner believes that the limitation "*wherein the embossed patterns in the face panels provide the garage door with the simulated appearance of at least two separate, cooperating vertically-hung doors when the garage door is in a closed position*" is a subjective limitation, and therefore should not be given substantial patentable weight. The Applicant disagrees. The Court of Appeals for the Federal Circuit has confirmed that inventions designed to have the appearance of something else are properly the subject of utility patent protection:

The fact that one product can be altered to make it look like another is in itself a specific benefit sufficient to satisfy the statutory requirement of utility. It is not unusual for a product to be designed to appear to viewers to be something it is

not. For example, cubic zirconium is designed to simulate a diamond, imitation gold leaf is designed to imitate real gold leaf, synthetic fabrics are designed to simulate expensive natural fabrics, and imitation leather is designed to look like real leather. In each case, the invention of the product or process that makes such imitation possible has "utility" within the meaning of the patent statute, and indeed there are numerous patents directed toward making one product imitate another. See, e.g., U.S. Pat. No. 5,762,968 (method for producing imitation grill marks on food without using heat); U.S. Pat. No. 5,899,038 (laminated flooring imitating wood); U.S. Pat. No. 5,571,545 (imitation hamburger). Much of the value of such products resides in the fact that they appear to be something they are not.

*Juicy Whip Inc. v. Orange Bang Inc.*, 185 F.3d at 1367-68, 51 USPQ2d at 1703 (1999).

Because Leist does not disclose embossed patterns that "provide the garage door with the simulated appearance of at least two separate, cooperating vertically-hung doors when the garage door is in a closed position," the reference does not include every limitation recited in any one of claims 1, 2 and 5-7. Accordingly, the rejection of claims 1, 2 and 5-7 under 35 USC 102(b) should be withdrawn.

## **II. Claims 1-29 are Patentable Over Leist et al. in View of Forsland**

### **a. The Examiner has the Burden to Establish a Prima Facie Case of Obviousness**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. See MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

**b. The Office Action Does Not Set Forth a Prima Facie Case of Obviousness**

Claims 1-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Leist et al.** in view of U.S. Pat. No. 6,446,695 to **Forsland**. Specifically, the Office Action states that **Forsland** discloses a multi-pancled garage door which simulates double doors, and that it would have been obvious to modify **Leist** to provide the overhead door with the appearance of the **Forsland** doors. The Office Action further states that though **Leist** does not simulate typical doors as presently disclosed, **Forsland** is clearly concerned with decorative appearances.

Independent Claim 1 (and each of depending claims 2-7) recites an overhead garage door that includes a plurality of rectangular garage door sections. Each door section includes at least one thin-walled face panel and one or more patterns embossed in the face panel. The embossed patterns in the face panels cooperate to provide the garage door with the simulated appearance of at least two separate, cooperating vertically-hung doors when the garage door is in a closed position. Neither **Leist** nor **Forsland** describe an overhead door that includes door sections having thin-walled face panels including one or more embossed patterns that cooperate to provide the door with the required simulated appearance. Indeed, **Leist** describes a substantially conventional metal overhead door like that described in the background section of the present specification at page 1, line 18 to page 2, line 22. As shown in Figure 1 of **Leist**, the rectangular ornamental patterns on the door panels (14) of **Leist** appear to be arbitrarily arranged in rows and columns, and do nothing to impart the appearance of anything other than a single, conventional overhead door. **Forsland**, on the other hand, describes a single roll-up door with a plural door facade like that described in the background section of present specification at page 3, line 7 to page 4, line 8. The plural-door facade of **Forsland** is formed by affixing wooden members to the outer faces of thick-walled, non-metal door panels, and does not achieve a plural door appearance by virtue of any arrangement of patterns embossed in a thin-walled face panel as claimed. Therefore, the cited references fail to teach or suggest all of the claim limitations. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 1-7 under 35 USC 103(a) should be withdrawn.

Independent claim 8 (and each of depending claims 9-21) recites an overhead garage door having upper and lower sections each having an integrally-formed substantially vertical groove substantially extending between the upper and lower edges of each section. The vertical grooves are substantially collinear when the garage door is in the closed position, thereby substantially simulating the appearance of a vertical separation between left and right portions of the upper and lower sections. Neither **Leist** nor **Forsland** discloses upper and lower door sections having such cooperating integrally-formed substantially vertical grooves. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 8-21 under 35 USC 103(a) should be withdrawn.

Independent claim 22 (and each of depending claims 23-26) recites an overhead garage door that includes an embossed pattern in a thin-walled face panel. The embossed pattern includes an integrally-formed panel portion having a substantially planar portion that includes a plurality of spaced, parallel vertical grooves. The substantially planar portion thereby substantially simulates the appearance of a non-metal panel formed by a plurality of assembled tongue-and-groove planks. Neither **Leist** nor **Forsland** discloses an embossed thin-walled door panel having an integrally-formed panel portion with a substantially planar portion, and including a plurality of spaced, parallel vertical grooves. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in

the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 22-26 under 35 USC 103(a) should be withdrawn.

Independent claim 27 (and each of depending claims 28 and 29) recites an overhead garage door having an integrally embossed pattern in a thin-walled face. The embossed pattern includes an integrally-formed panel portion having a rectangular frame portion bordering top, bottom, and side margins of the raised panel. A recessed substantially planar panel portion is disposed within the rectangular frame portion, and at least one integrally-formed, diagonally-oriented, simulated support member is disposed within the frame portion of the panel. Neither **Leist** nor **Forsland** discloses an integrally-formed, diagonally-oriented, simulated support member disposed within the frame portion of an embossed panel. Indeed, neither **Leist** nor **Forsland** disclose a diagonal support member of any type. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Leist**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Accordingly, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 27-29 under 35 USC 103(a) should be withdrawn.

For these reasons, a *prima facie* case of obviousness has not been established, and the rejections of claims 1-29 under 35 USC §103(a) should be withdrawn.

**Conclusion**

The Applicant believes that claims 1-29 are in condition for immediate allowance, and such action is respectfully requested. If any issue remains unresolved, Applicant's attorney welcomes a telephone call from the Examiner to expedite allowance of the claims.

Respectfully submitted,



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